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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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BELL, BOYD & LLOYD LLC
P. O. BOX 1135
CHICAGO, IL 60690-1135

EXAMINER	
ENATSKY, AARON L	
ART UNIT	**PAPER NUMBER**
3713	3

DATE MAILED: 12/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N . 09/919,022	Applicant(s) BAERLOCHER ET AL.	
	Examiner Aaron L Enatsky	Art Unit 3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 July 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-49* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-49* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-2, 7, 12-13, and 23-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 7, 10-11, 13 of U.S. Patent No. 6,602,136. Although the conflicting claims are not identical, they are not patentably distinct from each other because '136 provides a game with a path, player and terminating symbols, symbol movement, and bonus values associated with game events.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-25, 47-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 1, 23, and 47 are claimed as gaming apparatuses. However, claim language is also directed to methods of operating a game, which renders the claim indefinite for

failing to specify the metes and bounds of the claim language. Applicant needs to clarify the claims to require only a method or only an apparatus.

Claims 26-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 26, 37, and 41 all claim methods for performing game functions, but all lack the means to appropriately show how the functions are performed or what is performing the game functions.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9, 13-14, 23-24, 26-27, 31, 34, 37-49 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6,517,432 to Jaffe.

Claims 1, 23-24, 26, 37-38, 41-42, 44, 46: Jaffe teaches a path including a plurality of locations (Figs. 5, 7, 9, 11, 12), a bonus value associated with at least one of the locations (5:21-24), at least one player symbol and at least one terminating symbol (5:12-15), and a display device which displays the path and the symbols to the player (2:36-42). The processor, electronically connected to the display device, which: (a) causes the player symbol to visit at least one of the locations on the path (5:12-15); (b) causes the terminating symbol to visit at least

one of the locations on the path (5:12-15); and (c) provides the player with any bonus value associated with the location visited by the player symbol (5:21-36).

Claims 2, 27, 40, 45, 47-48: Jaffe teaches the path used by the player and terminator symbol is random (5:12-15 and 5:43-47). The play field is also shown in a matrix array (Fig. 6-13), which would allow a cyclical path, depending on the random outcome generated by the processor.

Claims 3-4, 14, 31, 39: Jaffe teaches a game termination when both player and terminating symbol occupy the same place on a path (6:4-12).

Claims 5-6, 49: Jaffe teaches the game termination as discussed in claims 3-4, which states that when player symbols occupy the same space at the same time, the game ends. A pass would have both symbols occupy the same space at the same time, thus ending the game.

Claim 7: Jaffe teaches sequential location visitation until a predetermined count (6:4-12).

Claims 8-9, 13, 34, 43: Jaffe teaches a move indicator displayed on the display device by moving the player and terminator symbol from one location to another as discussed above. The moves only come in response to player-initiated input (3:4-9).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 10-12, 15-22, 28-30, 32-33, 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jaffe as applied to claims 1-9, 13-14, 23-24, 26-27, 31, 34, 37-49 above, and further in view of US Patent No. 6,520,855 to DeMar et al. (DeMar).

Claims 10-12, 28-30: Jaffe teaches the claimed limitation as discussed above, but does not teach lap indicators. DeMar teaches a bonus game with features taken from a game called ~~MONOPOLY~~ MONOLOPY™ (5:1-5) such as a cyclical path (Fig. 3) and player character (Fig. 5). The bonus game also includes a lap indicator as well as bonuses for completed laps (Fig. 16b and 37:6-23). One would be motivated to modify Jaffe to include the additional bonus features as Jaffe teaches that developing and adding new features to bonus games satisfies the demands of both players and operators (1:45-53). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Jaffe and add the additional bonus features taught by DeMar to enhance the existing bonus game by adding new features, thus satisfying demands of players and operators.

Claims 15 and 32: DeMar teaches a path including a predetermined number of laps along a path (37:24-28).

Claim 16: DeMar teaches a lap bonus value as discussed in claims 10-12.

Claim 17: DeMar teaches a lap bonus for each lap completed by a player as discussed in claims 10-12.

Claim 18: Jaffe teaches a move indicator as discussed in claims 8-9 and 13.

Claims 19-20: DeMar teaches a lap and bonus indicator as discussed in claims 10-12.

Claim 21: DeMar teaches a player symbol with a starting path (22:16-19 and 11:31-38).

Claims 22 and 36: Jaffe in view of DeMar teaches the limitation as discussed above, but does not teach a sound associated with a visit to a location. However, DeMar teaches that an animation is associated with at least one location in a game (41:65-67). As is known in the art, animation and sounds are equivalents in terms of player sensory stimulators, and thus would have been considered within the capabilities of one of ordinary skill at the time of the invention to either replace or include sound associated with a visit to a location to further enhance the existing bonus game additional features. Furthermore, placement of sound and animation does not serve to modify any structural changes in the game play/outcome other then aesthetic value, thus any improvements thereof would have been considered within the capabilities of one of ordinary skill at the time of the invention.

Claims 33 and 35: DeMar teaches awarding a bonus values for completed laps as discussed in claims 10-12. Any bonus earned for a complete lap also means that a player has not yet been caught.

Claim 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jaffe in view of DeMar as applied to claims 1-24, 26-49 above, and further in view of US Patent No. 6,033,307 to Vancura.

Claim 25: Jaffe in view of DeMar teaches the limitations as discussed above, but does not teach an outcome as a deduction from a bonus award provided to a player. Vancura teaches a gambling game with a bonus game (Abstract) where an outcome can be a deduction from a bonus award (Fig. 5). One would be motivated to modify Jaffe in view of DeMar to include the additional bonus features as Jaffe teaches that developing and adding new features to bonus games satisfies the demands of both players and operators (1:45-53). Therefore, it would have

been obvious to one of ordinary skill in the art at the time the invention was made to modify Jaffe in view of DeMar and add the additional bonus features taught by Vancura to enhance the existing bonus game by adding new features, thus satisfying demands of players and operators.

Citation of Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Pat. No. 5,547,201 to Honeywill teaches a game with a circular path.

US Pat. No.6,176,487 to Eklund et al. teaches a game with path determination.

US Pat. No. 6,494,785 to Gerrard et al. teaches a game with symbol movement along a path.

US Pat. No. 6,290,600 to Glasson teaches a game with symbol movement along a path.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron L Enatsky whose telephone number is 703-305-3525. The examiner can normally be reached on 8-6 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on 703-308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Aaron Enatsky
12/10/03
MON

Teresa Walberg
Supervisory Patent Examiner
Group 3700